

REMARKS

Claims 36-64 are pending in the present application. None of the claims were amended in this response.

Claims 36 and 56 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action alleged that the limitation “wherein the reception of data packets to be detected and the characteristic data packets occurs parallel” recited in claim 36 and similarly in claim 56 was not described in the specification in such a way to reasonably convey to one skilled in the relevant art that the inventor, at the time of the application was filed, has possession of the claimed invention. Applicant respectfully traverses this rejection.

The present specification, page 9, second paragraph, discloses that a GSM frame transmitted by the GSM base station contains eight timeslots, each of which contains a data packet dp. The data packets transmitted by the GSM base stations BS2, such as the frequency correction data packet FB (characteristic data packet, FCCH data packet, Frequency Correction Burst), the synchronization data packet SB (the data packet which is to be detected, SCH data packet, Synchronization Burst) and the normal data packet are all subject to the same time pattern. On page 11, second-to-last paragraph, the present specification teaches that, as explained in Figure 5, both the FCCH data packet FB and the SCH data packet SB are used in parallel for synchronization. As a result, search speeds are significantly increased over known methods of doubling the number of FCCH data packets. Figure 5 illustrates under the exemplary embodiment that the FB (characteristic data packet) and SB (data packet to be detected) are received in parallel (see RHS of Figure).

Applicants submit that the rejection under 35 U.S.C. §112, first paragraph is improper. There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) (MPEP 2163). Prior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should review the claims and the entire specification, including the specific embodiments and figures, to understand how applicant provides support for the various features of the claimed invention. Each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent

with the written description. See, e.g., *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). The entire claim must be considered, including the preamble language and the transitional phrase. Possession may be shown in many ways. For example, possession may be shown by describing an actual reduction to practice of the claimed invention. Possession may also be shown by a clear depiction of the invention in detailed drawings which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention. An adequate written description of the invention may be shown by any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would recognize that the inventor had possession of the claimed invention (MPEP 2163). Withdrawal of this rejection is respectfully requested.

Claims 36-45 and 56-64 were rejected under 35 U.S.C. §102(b) as being anticipated by *Grimlund* (WO 94/29981). Claim 46 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Grimlund* (WO 94/29981) in view of *Ault et al.* (US Patent 5,754,542). Claims 47-55 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Grimlund* (WO 94/29981) in view of *Bruckert et al.* (US Patent 5,812,542). Applicant respectfully traverses these rejection. Favorable reconsideration is respectfully requested.

Specifically, the cited art, alone or in combination, does not teach “switching, during interruption phases, the mobile station to reception of the data packets to be detected and transmitted by the second base station using the second transmission method, wherein the reception of data packets to be detected and the characteristic data packets occurs parallel” as recited in claim 36, and similarly recited in claims 47 and 56 (“simultaneous”).


As argued previously, *Grimlund* discloses a system and method where the characteristic data packet is received first (i.e., serially), processed, and then continues with obtaining the data packets to be detected (page 9, lines 19-25). Accordingly, *Grimlund* does not disclose every feature of the presently amended claims and is improper. Furthermore, in light of Applicant’s traversal of the rejection under 35 U.S.C. §112, the claims are patentably distinguished from *Grimlund*. Withdrawal of the rejection is respectfully requested.

In addition to the above arguments, the *Ault* and *Bruckert* references do not cure the deficiencies of *Grimlund*. As such, Applicant respectfully submits that the rejection under 35 U.S.C. §103 is also improper. Withdrawal of the rejection is respectfully requested.

In light of the above, Applicants respectfully submit that claims 36-64 are both novel and non-obvious over the art of record. Accordingly, Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (0112740-197) on the account statement.

Respectfully submitted,

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